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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/031,218   | 05/07/2002  | Marcus Filshie       | 02597               | 2627             |
| 987 7590 10/27/2008<br>SALTER & MICHAELSON<br>THE HERITAGE BUILDING<br>321 SOUTH MAIN STREET<br>PROVIDENCE, RI 029037128 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| ERIZO, DARWIN P  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/031,218

**Applicant(s)**

FILSHIE ET AL.

**Examiner**

Darwin P. Erez

**Art Unit**

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 4 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/19/07 has been entered.

### ***Claim Objections***

2. Claims 4 and 13 are objected to because of the following informalities:

In claim 4, "second arcuately shaped portion" should read --second arcuate shaped portion--.

In claim 13, "pen" should read --pin--.

-Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 17 recites the limitation "the outer contact side" and "the inner side" in line

2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

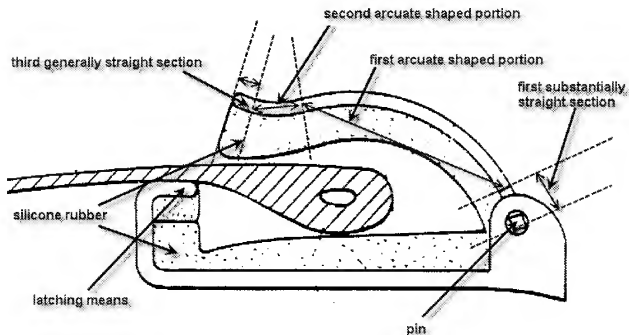
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4-9 and 11-22 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,489,725 to Casey et al.

- As seen in the attached Fig. 3(a) below, Casey discloses a surgical clip comprising:
  - an elongate upper jaw and an elongate lower jaw attached together at a first hinge end;
  - the lower jaw being provided with latching means at an opposite end to the hinge;
  - the jaws being provided with a silicone rubber lining;
  - the upper jaw comprising a complex shape comprising:
    - a first substantially straight section adjacent to the hinge,
    - a second arcuate shaped section adjoining the straight section and in which the second arcuate shaped section comprises:
      - a first arcuate shaped portion adjacent to said substantially straight section, and
      - a second arcuate shaped portion adjacent to said first arcuate shaped portion at an opposite end of said first arcuate shaped portion to said substantially straight section,

- wherein said first arcuate shaped portion having a first radius of curvature on at least its outer contact surface that is substantially greater than the radius of curvature of said second arcuate shaped portion which has a second radius of curvature.
- a third generally straight section adjacent to said second arcuate shaped portion, said generally straight section, when in the closed position of the clip interlocking under the latching section of the lower jaw;
- wherein the third generally straight section is viewed as the distal generally straight section having a free end that is contiguous with the second arcuate shape section;
- wherein the first arcuate shaped portion has the same width therealong and as measured in the direction of the first radius of curvature;
- wherein said second arcuate shaped section has the same width therealong and as measured in the direction of the second radius of curvature;
- wherein the upper jaw is distorted to fit within the latch means (see transition from Figs. 3(a) to 3(e));
- wherein the first arcuate shaped portion is contiguous with the second arcuate shaped portion to form a complex contiguous curved shape;
- wherein there is an absence of a straight portion between the first and second arcuate shaped portions;

- wherein the upper and the lower jaws are connected by a hinge pin;
- wherein the clip is fully capable of being inserted through a tubular member having a dimension bigger than the clip (note that the tubular member is not positively recited in claims 14 and 15);
- wherein the second arcuate shaped section has an arcuate portion on either an outer and inner side thereof.



***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casey et al., as applied to the rejection to claim 1 above.

Casey discloses all limitations of the claims except for the ratio of curvature between the first radius of curvature and the second radius of curvature. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify curvature of the first or second arcuate shaped portion to have the recited ratio because since it has been held that changing the shape of a working part involves only routine skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). It has been held that discovering an optimum value (the ratio of curvature between the first radius of curvature and the second radius of curvature) of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Casey also discloses the use of a clip closure member (applicator, see abstract) but is silent with regards to the applicator imposing pressure on only the straight section of the clip. However, it would be a mere obvious design choice to one of ordinary skill in the art to modify the device of Casey to have the applicator only applying pressure on the straight sections of the clip because applying pressure only on the straight portions or only on the curved portions will produce the same result of forcing the clip into a clamped position.



### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-4, 7-9, 11-13 and 16-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 7, 8, 10-13, 17 and 18 of U.S. Patent No. 6,699,258. Although the conflicting claims are not identical, they are not patentably distinct from each other because each structural limitations disclosed in the application are disclosed in the patent. For example, both recite a clip having an upper jaw and a lower jaw; a silicone rubber lining; the upper jaw having a first substantially straight section, a first and second arcuate shaped portions; a third generally straight section; the lower jaw having a latching means. The difference merely lies in the terminology used in the claims, which would be obvious to one of ordinary skill in the art.

***Response to Arguments***

14. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who whose telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erez/  
Primary Examiner, Art Unit 3773